

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on October 3, 2006, the Examiner rejected claims 1, 4-5, 8-9, 12-15, and 19 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0104090 to Stettner (hereinafter “Stettner”) and rejected claims 29-31 and 38 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,028,327 to Dougherty et al. (hereinafter “Dougherty”). In addition, the Examiner rejected claims 2, 10, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Stettner in view of U.S. Patent Application Publication No. 2001/0007105 to Brotz et al. (hereinafter “Brotz”), rejected claims 3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Stettner in view of Patent Application Publication No. 2002/0144265 to Connelly (hereinafter “Connelly”), rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Stettner in view of Connelly and further in view of “The Set-Top Box as ‘Multi-Media Terminals’” by Pekowsky and Jaeger (hereinafter “Pekowsky”), rejected claims 32 and 36-37 under 35 U.S.C. § 103(a) as being unpatentable over Dougherty in view of U.S. Patent Application Publication No. 2002/0073416 to Ramsey Catan (hereinafter “Ramsey Catan”), rejected claims 33-34 under 35 U.S.C. § 103(a) as being unpatentable over Dougherty in view of Ramsey Catan and further in view of U.S. Patent Application Publication No. 2002/0010935 to Sitnik (hereinafter “Sitnik”), and rejected claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Dougherty in view of Brotz. Accordingly, Applicant respectfully provides the following:

Rejections under 35 U.S.C. 102:

In the Office Action, the Examiner rejected claims 1, 4-5, 8-9, 12-15, and 19 under 35 U.S.C. § 102(e) as being anticipated by Stettner and rejected claims 29-31 and 38 under 35

U.S.C. § 102(e) as being anticipated by Dougherty. Applicant respectfully submits that the claim set as provided herein is not anticipated by the cited references.

The standard for a Section 102 rejection is set forth in M.P.E.P 706.02, which provides:

[F]or anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.

Applicant respectfully submits that the cited references do not explicitly or impliedly teach every aspect of the amended claim set as provided herein and therefore does not anticipate the claims of the present invention.

Rejection of Claims 1, 4, 5, 8, 9, 12-15, and 19 as being anticipated by Stettner:

Applicant has amended claim 1 to more clearly define over the cited art. In particular, claim 1 now claims “a software appliance apparatus for locally enhancing, at the software appliance apparatus, a remote programming broadcast,” and requires “a data structure contained and stored on said memory device, said data structure configured to locally enhance, at the software appliance apparatus, said programming broadcast with a local service that provides at least one of (i) content and (ii) functionality to said programming broadcast, wherein said local service is provided by a local service provider without notification to the remote service provider and wherein said local service bypasses said remote service provider and bypasses a distribution system used for said remote programming broadcast.” The system shown in Stettner cannot be said to locally enhance, at the software appliance apparatus, a programming broadcast.

In the Office Action, the Examiner improperly treated the elements recited in claim 1 to include both remote and local elements. In particular, although claim 1 recited a software appliance apparatus for locally enhancing a remote programming broadcast, the Examiner relied

on elements from Stettner that happen remotely as disclosing Applicant's local enhancement. Specifically, the Examiner cited the "local studio 106" that inserted an advertisement before the signal was transmitted by the cable service provider 108 (Figs 1 and 2) to the user as teaching the local enhancement. Applicant respectfully submits that the enhancement disclosed by Stettner and relied on by the Examiner is not local but remote. However, in response, Applicant has amended the claim to more clearly define that the enhancement of the programming broadcast occurs at the software appliance apparatus, and therefore the claim limitation clearly defines over Stettner in that the enhancement of the programming broadcast must occur at the software appliance apparatus.

In addition, claim 1 requires that the local service bypasses the remote service provider and bypasses a distribution system used for said remote programming broadcast. The enhancement of Stettner neither bypasses the remote service provider nor bypasses the cable distribution system, as the local studio's advertisement is added to the broadcast before it is received by the cable service provider 108 and then transmitted over the cable service provider's distribution system. Therefore Stettner fails to teach this claim limitation as the service of Stettner is transmitted to the remote service provider (the cable service provider), and is transmitted over the same distribution system as is used for the remote programming broadcast.

As Stettner fails to teach every element of claim 1, claim 1 is not anticipated by the cited reference. Independent claims 9 and 15 contain similar limitations and are at least allowable for the same reasons. Specifically, claims 9 and 15 require receiving, at a receiving device, a programming broadcast from a remote service provider, and "locally enhancing the programming broadcast with a local service . . . provided by a local service provider to said receiving device without notification to the remote service provider and wherein said local

service bypasses said remote service provider and bypasses [the service provider's] distribution system" For at least these reasons, claims 9 and 15 are not anticipated by Stettner. Claims 2-5, 8, 10-14, 16-17 and 19 depend from one of claims 1, 9, and 15 and are at least allowable for the same reasons. Applicant therefore respectfully requests removal of the rejections of claims 1, 4, 5, 8, 9, 12-15, and 19 as being anticipated by Stettner.

Rejection of Claims 29-31 and 38 as Being Anticipated by Dougherty:

Applicant has amended claim 29 to more clearly define over the cited art. Specifically, claim 29 now includes limitations of "a first programming broadcast data stream containing multiple simultaneous broadcast video components," "a local service provided by a local service provider without notification to the remote service provider," "adding the local service to the first programming broadcast data stream with the software appliance, wherein the addition of the local service bypasses the remote service provider," and "generating a second programming broadcast data stream containing multiple simultaneous broadcast video components at the output signal encoder and modulator, the second broadcast data stream containing the multiple simultaneous broadcast video components from the first programming broadcast data stream and the local service." The claimed combination of limitations is not disclosed by Dougherty.

In the Office Action, the Examiner indicated that Dougherty teaches a local service provided by a local service provider without notification to the remote service provider. Applicant respectfully disagrees. Dougherty teaches, instead, that the remote service provider is aware of and controls the addition of the interactive content taught by Dougherty. Specifically, Dougherty teaches that the Data Insertion Unit 336 (Fig 3) inserts commands and data into the broadcast stream. (Col 12 lines 5-7) The commands in the broadcast stream are what instruct

the receivers to “trigger elements of interactive applications or to start, stop, cancel, suspend, or resume interactive applications currently being received or already resident in memory.” (Col 12 lines 7-11; see also Col 19 lines 19-23 and Col 3 line 59-Col 4 line 7.) Thus, the remote service provider is the ultimate provider of the interactive content and remains in control if it is able to start, stop, cancel, suspend, or resume the applications, regardless of whether the applications are being simultaneously received or whether they are already resident in the local equipment. This can hardly be termed a local service “without notification to the remote service provider” as is contained in claim 29.

Additionally, claim 29 now requires an input programming broadcast data stream containing multiple simultaneous broadcast video components and an output programming broadcast data stream containing multiple simultaneous broadcast video components as well as the local service that was added without notification to the remote service provider. These limitations are taught by the specification as filed on pages 9-10. This requirement clearly defines over Dougherty, which only discloses a single program output with some additional interactive content. (See entire Summary of the Invention, which refers only to outputting and linking interactive content to a single broadcast program at a time.) Therefore, Applicant’s claimed invention is not anticipated by Dougherty as Dougherty at least fails to teach the discussed limitations.

Claims 30-38 depend from claim 29 and are at least allowable for the same reasons. Applicant therefore respectfully requests removal of the rejections of claims 29-31 and 38 as being anticipated by Dougherty.

Rejections under 35 U.S.C. 103

The Examiner rejected claims 2, 3, 10, 11, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of references with Stettner and rejected claims 32-37 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of references with Dougherty. Applicant respectfully submits that the claim set as provided herein is not made obvious by the cited references.

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added.) Applicant respectfully submits that the references cited by the Examiner do not teach or suggest the limitations claimed in the present application.

As discussed above, independent claim 1 recites “a software appliance apparatus for locally enhancing, at the software appliance apparatus, a remote programming broadcast,” and requires “a data structure contained and stored on said memory device, said data structure configured to locally enhance, at the software appliance apparatus, said programming broadcast with a local service that provides at least one of (i) content and (ii) functionality to said programming broadcast, wherein said local service is provided by a local service provider without notification to the remote service provider and wherein said local service bypasses said remote service provider and bypasses a distribution system used for said remote programming broadcast.” Independent claims 9 and 15 contain similar limitations, as discussed above.

In contrast, none of the references cited by the Examiner, alone or in combination, teach or suggest such limitations. As discussed above, Stettner does not teach these limitations, and none of the other references cited by the Examiner teach these limitations. Therefore, the independent claims 1, 9, and 15 are not made obvious by the cited references, either alone or in combination. In addition, the dependent claims place further limitations on otherwise allowable subject matter. Accordingly, Applicant respectfully submits that for at least these reasons the cited references do not teach or suggest, alone or in combination, the limitations claimed in the present claim set and therefore do not make obvious claims 2, 3, 10, 11, 16, and 17 as provided herein.

As discussed above, independent claim 29 now includes limitations of “a first programming broadcast data stream containing multiple simultaneous broadcast video components,” “a local service provided by a local service provider without notification to the remote service provider,” “adding the local service to the first programming broadcast data stream with the software appliance, wherein the addition of the local service bypasses the remote service provider,” and “generating a second programming broadcast data stream containing multiple simultaneous broadcast video components at the output signal encoder and modulator, the second broadcast data stream containing the multiple simultaneous broadcast video components from the first programming broadcast data stream and the local service,” and the claimed combination of limitations is not disclosed by Dougherty. Applicant respectfully submits that the claimed combination is also not taught by the other cited references. Therefore, independent claim 29 is not made obvious by the cited references, either alone or in combination, and the corresponding dependent claims are similarly allowable. Therefore claims 32-37 are

patentable over the cited references. Applicant therefore respectfully requests removal of all rejections under 35 U.S.C. § 103(a).



CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 2 day of January, 2007.

Respectfully submitted,



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